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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,631	10/11/2001	Robert E. Haines	10007586-1	1657

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EXAMINER

FLEMING, FRITZ M

ART UNIT PAPER NUMBER

2182

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/976,631

Applicant(s)

HAINES, ROBERT E.

Examiner

Fritz M Fleming

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

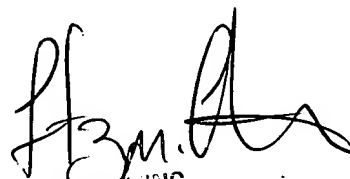
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.


FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/11/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 3 lack proper antecedent basis for "the configuration plug in..." of claim 2 and the "wherein downloading includes" of claim 3, making appear as though claim 1 is missing some material.

Double Patenting

3. Claims 10 and 23 objected to under 37 CFR 1.75 as being a substantial duplicate of claims 11 and 24. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-27 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 09/976,642 [2003/0074268] in view of claims 1-26 of 09/976,626 [2003/0074427]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims set forth initially the configuring via a hotlink, and then the determining of the type of hard copy engine and then the setting of thresholds and the sending of communications. Claims 1-26 of 09/976,626 are directed to various embodiments of electronic messages including configuration data and then configuring the hard copy engine accordingly, with an embedded web server, firewalls, thresholds of consumables, printers, determining of make and model, while claims 1-27 of 09/976,642 are directed to determining consumable thresholds and e-mails to order accordingly, firewalls, toner, work thresholds, embedded web servers. Thus the instant claims are rendered obvious by the combined teachings and limitations of the other two co-pending applications, as the instant claims represent a combination of the co-pending claims. Therefore it would have been obvious to one having ordinary skill in the art at the time that the invention was made to combine the teachings and claims of the two copending applications in order to configure determine and order consumables over a network. It is applicants' responsibility to keep a clear line of demarcation between the various pending applications in order to avoid double patenting rejections.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1,6,8,13,15,19,21,26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groezinger in view of Venkatraman et al. (Venkatraman) and Ely et al. (Ely).

Groezinger teaches network configuration of a hard copy output engine in the form of the medical imager 30 such as a continuous tone laser imager and imaging element 50 to include a processing station for chemical processing or photothermographic processing. See column 3, lines 63+ and configuration of the imager 30 via the client 40 over a TCP/IP link 48, noting the use of an embedded web server 38. See also

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column 6, lines 55+ wherein the technician is able to access the internal web server of the imager 130 in order to configure each imager 130. What is lacking is express teaching of the use of a hot link to configure the imager.

Venkatraman teaches the use of an embedded web server 14 to allow a device to be configured via the various network configurations shown in the Figures. The device is shown to be a printer per column 4. It is specifically stated at column 3, lines 17-26 that each device has a URL. Configuration of the printer is permitted via the information of Figure 3, as configuration involves any of the data displayed in Figure 3. Thus, what is taught, is that an embedded web server device is reached via a URL accessed by a client.

Ely teaches the use of a "hot link" to reach a URL per column 2, lines 9+. Thus per column 1, lines 66+, when one activates a "hot link", the client browser obtains the web page associated with the URL of the "hot link".

Therefore it would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify the teachings of Groezinger per Venkatraman and Ely for the express purpose of being able to carry out the configuration of the imager via the client on a TCP/IP via a URL associated with a hot link that is activated by the user to access the associated embedded web browser. As the combined teachings are computer based, an article of manufacture of the computer useable medium, a computer implemented control system, and a computer instruction signal are also rendered obvious.

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4. Claims 2,3,5,7,9,12,14,16,17,20,22,25,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groezinger in view of Venkatraman et al. (Venkatraman) and Ely et al. (Ely) as applied to claims 1,6,8,13,15,19 and 21,26 above, and further in view of Danknick et al. (Danknick).

Groezinger in view of Venkatraman et al. (Venkatraman) and Ely et al. (Ely) lack the determining of thresholds and sending of electronic messages.

Danknick teaches the use of remote servicing and maintenance per column 13+, wherein the technician access the copier by entering the address of the copier into the web browser, with automatic service requests generated per column 16+ and determined by a threshold of pages printed, wherein such is an example of a consumables threshold being exceeded. Then an automatic electronic message is sent to the vendor associated location workstation 1, with then an e-mail sent to workstation 9 to advise of the service request. See for example the web page 19 which is generated in this process, with a hot link of the printer included at 202. This is a part of an overall downloading of the web pages described above (i.e. Figure 19). During the process of Figure 20. Note embedded server 64 which allows external workstations to access the NIB. Per Figure 16, make and model of the device are determined in conjunction with the servicing and thresholds. A serial number is seen in the MAC address of Figure 10.

Therefore it would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify Groezinger in view of Venkatraman et al. (Venkatraman) and Ely et al. (Ely) per the teachings of Danknick so as to allow for the

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ability to perform remote and automated threshold servicing based upon the make and model of the network device. Note also that Venkatraman teaches the use of additional web pages in Figure 3 to allow for the servicing or ordering of supplies or parts lists for the associated and identified printer, to include the printer name, which is thus downloaded from the printer server, thereby helping to determine the make and model (from a printer name) downloaded from the embedded web server in the printer itself. As pointed out above, the combined teachings are computer based, an article of manufacture of the computer useable medium, a computer implemented control system, and a computer instruction signal are also rendered obvious.

5. Claims 4,10,11,18,23,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groezinger in view of Venkatraman et al. (Venkatraman) and Ely et al. (Ely) and further in view of Danknick et al. (Danknick) as applied to claims 1-3,5-9, 12-17,22,25-27 above, and further in view of Motoyama.

The combined teachings of Groezinger, Venkatraman, Ely and Danknick fail to teach the transmission across a firewall.

Motoyama in the same field of network device communications, shows that firewalls 14,50 are in networks and that electronic messages will cross these firewalls when network devices are in communication. The purposes of the firewalls [0014] is to allow only authorized computers to access the network, noting that network devices include the printers 32 and 26. Thus communications between computers and printers will cross the firewalls where appropriate (i.e. 56-32).

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Therefore it would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify the teachings of Groezinger, Venkatraman, Ely and Danknick per the teachings of Motoyama for the express purpose of providing firewalls on parts of the network to only allow authorized computers to access the network. Thus the overall network of the combined teachings includes firewalls where appropriate, and thus communications between the printers and workstations will cross the firewalls as seen in Motoyama. As pointed out above, the combined teachings are computer based, an article of manufacture of the computer useable medium, a computer implemented control system, and a computer instruction signal are also rendered obvious.

Conclusion


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. EP 1 039 692 teaches network peripheral server discovery. Spofford teaches embedded server management. EP 0 685 768 shows consumables management. Schlonski et al. teach printer managing. Trzcinko et al. teach web based network management. 2003/0074547 is the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fritz M Fleming whose telephone number is 571-272-4145. The examiner can normally be reached on M-F, 0600-1500.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Fritz M Fleming
Primary Examiner
Art Unit 2182

fmf